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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/500,439
Filing Date: February 09, 2000
Appellant(s): RUVOLO ET AL.

Ramraj Soundararajan
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 01, 2004.

(1)   *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2)   *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3)   *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4)   *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5)   *Summary of Invention*

The summary of invention contained in the brief is correct.

(6)   *Issues*

The appellant's statement of the issues in the brief is correct.

(7)   *Grouping of Claims*

The rejection of claims 1-2, 4-15, 17-26, and 28-37 stand or fall together because

appellant's brief does not include a statement that this grouping of claims does not

stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8)   *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   *Prior Art of Record*

5,831,611   Kennedy   11-1998

http://web.archive.org/web/*/http://www.chez.com/svs/XcontactUS.html, Jan. 1, 1996

(10)   *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims. The

ground(s) for rejection are reproduced below from the final Office Action and are

provided here for the convenience of both Appellant and the Board of Patent Appeals.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention
> was made.

   **Claims 1-2, 4-15, 17-26 and 28-37 are rejected under 35 U.S.C. 103(a) as being unpatentable
over Kennedy U.S. Patent No. 5,831,611 in view of Xcontact (PTO-892, Ref U).**

   Referring to claim 1. Kennedy discloses a computer-based method of dynamically presenting
potential contacts to a user comprising the following steps:

   • Retaining user preferences, wherein said user preferences comprise any of, or a combination of:
      professional or personal contacts, preference on initiating the searching step, time-based
      references, select algorithms, or maximum number of candidates to select (Kennedy: column 1,
      lines 26-37, "Businesses are now able to keep large amounts of information on business contacts
      in databases, and the businesses are able to retrieve specific portions of the database according
      to complex search and sort algorithms");

   • Retaining a list of possible contacts, said list comprising at least identifying information of said
      contacts (Kennedy: column 1, lines 26-37);

   • Automatically initiating searching said list of possible contacts to select at least one potential
      contact based on said user preferences (Kennedy: column 1, lines 49-59, "...automatic follow-up
      reminders."),

   • Retaining said at least one potential contact selected during said search (Kennedy: column 2,
      lines 16-21), and

   • Displaying to the identifying information of said at least one potential contact identified during said
      automatic searching to automatically remind the user to stay in touch with said at least one
      potential contact (Kennedy: column 1, lines 49-59, "...automatic follow-up reminders.").

   Kennedy does not expressly disclose retaining and displaying available images of said contact.
Xcontact discloses retaining and displaying available images of said contact (Xcontact: page 2). Although
this form is not found in Kennedy, it would have been obvious to have provided the method of Kennedy to
have included the limitations as taught by Xcontact because the importance of communication with
current, former and future customers, vendors and co-workers is very important to the success of a
business (Kennedy: column 1, lines 15-27). Moreover, to have modified the method of Kennedy to have
included images would have been obvious to the skilled artisan because the inclusions of such

components would have been an obvious matter of design choice in light of the method already disclosed by Kennedy. Such modifications would not have otherwise affected the method of Kennedy and would merely represent one of numerous steps that the skilled artisan would have found obvious because the successful performance of a business relies upon establishing and then adhering to a set of contact communication protocols (Kennedy: column 1, lines 15-27) as disclosed by Kennedy et al.

Referring to claim 2. Kennedy further discloses user preferences wherein said user preferences comprise either preferences input by the user or pre-selected default preferences (Kennedy: column 1, lines 27-59).

Referring to claim 4. Kenned further discloses a list of contacts comprising any of: Name, organization, work address, home address, telephone numbers, pager numbers, cellular numbers, e-mail address, personal or professional identifiers, special dates, and contact dates (Kennedy: Figure 5).

Referring to claim 5. Kennedy further discloses a method wherein an automatic searching step is initiated automatically by a time-based reference (Kennedy: column 2, lines 46-58 and claims 12-13).

Referring to claim 6. Kennedy further discloses a method wherein a time-based reference comprises any of: frequency of contact, time between contacts, or calendar-based contact (Kennedy: column 2, lines 13-58).

Referring to claim 7. Kennedy further discloses a search module comprising, comparing applicable time-based references stored in said user preferences with said timer module, and upon a positive comparison, initiating said search (Kennedy: column 1, lines 38-59).

Referring to claim 8. Kennedy further discloses a method wherein selection of a potential contact in said search step is either random or based on a select algorithm (Kennedy: column 1, line 15 to column 2, line 10).

Referring to claim 9. Kennedy further discloses a method wherein said search step is repeated until said maximum number of candidates for selection has been achieved (Kennedy: Figure 15).

Referring to claim 10. Kennedy in view of Xcontact discloses a method according to claim 1 as indicated supra. Xcontact further discloses a computer-based method and system wherein displaying

step further comprises insertion of said available image or identifying information into a GUI (Xcontact: page 4).

Referring to claim 11. Kennedy in view of Xcontact discloses a method according to claim 10 as indicated supra. Xcontact further discloses a computer-based method and system wherein a GUI comprises an electronic organizer (at least page 2, *browser sample*).

Referring to claims 12 and 13. Kennedy further discloses a method wherein said method may be implemented locally or remotely on one or more computer based systems, across networks, LANs, WANs, cellular, Internet, Web-based networks or existing communication mediums (Kennedy: abstract).

The Examiner notes, the use of the term "may" as recited in claim 12 causes the limitation to be conditional and therefore is given little patentable weight.

Referring to claims 14-15 and 17-25. Claims 14-15 and 17-25 are rejected under the same rationale as set forth above in claims 1-2 and 3-13.

Referring to claims 26 and 28-37. Claims 26 and 28-37 are rejected under the same rationale as set forth above in claims 1-2 and 3-13.

(11) *Response to Argument*

Referring to claims 1, 14, and 26.

The Appellant argues (page 5 through page 7 of Appeal Brief) that Kennedy does not disclose the step of "retaining preferences" wherein the preferences comprise any of, or a combination of: professional or personal contacts, preference on initiating the searching step, time-based references, select algorithms, or maximum number of candidates to select.

The Appellant further argues (page 5 through page 7 of Appeal Brief) that there is no teaching in the citations for a system that reminds users to keep in touch with contacts based on user preferences.

The Examiner notes, Kennedy does disclose the step of "retaining preferences" wherein the preferences include, the preference on initiating a searching step. Claim 7 of Kennedy discloses a system including at least one database of business contacts, wherein a control event includes access to and evaluation of information from said at least one database. The events as described by Kennedy provide substantial assistance to businesses, which must frequently and regularly correspond with contacts and follow up on initial correspondence and meetings on a well-scheduled basis. The editing tools incorporated in Kennedy make designing a communication strategy with contacts virtually effortless (the strategy is based on the preferences of the businesses, i.e. user). The simple programming procedures provided by the graphically depicted

processes ensure that virtually anyone can program and use the process management system to custom design and implement an automated client/contact communication protocol (Kennedy: column 10, lines 8-19).

The Examiner further notes, Kennedy discloses (Kennedy: column 1, lines 33-37) that business are now able to keep large amounts of information on business contacts in databases, and the businesses are able to retrieve specific portions of the database according to complex search and sort algorithms. The goal of Kennedy is to enable businesses to quickly and easily develop custom contact communication protocols, which are then applied generally to a database of business contacts (column 2, lines 2-9). Kennedy automatically applies a communication protocol to a set of database entries representing a wide and diverse variety of business contacts in order to generate and execute a set of scheduled events (column 2, lines 16-21). The scheduled events within the communication process comprise inter-personal communications, including phone calls, letters, facsimiles, and appointments (time-based reference).

The Appellant contends that the examiner has failed to establish a prima facie case for obviousness under 35 U.S.C. 103(a) as the Kennedy reference fails to teach or suggest the claim limitation of a system that automatically searches through a list of contacts, based on retained user preferences, that a user has not stayed in touch with and automatically generates a reminder along with an available image of a potential contact reminding the user to stay in touch with the potential contact.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Examiner notes, the Appellant did not provide arguments traversing the combination of the Kennedy reference and the Xcontact reference.

Referring to claims 2 and 15.

The Appellant did not provide additional arguments, the Appellant contends that it would be moot to argue that Kennedy provides for setting preferences either by default or based on inputs by the user.

Referring to claims 4, 17, and 28.

The Appellant did not provide additional arguments, the Appellant contents that the arguments for independent claims 1, 14, and 26 substantially apply to corresponding dependent claims 4, 17, and 28.

Referring to claims 5, 19, and 29.

The Appellant did not provide additional arguments, the Appellant contents that

the arguments for independent claims 1, 14, and 26 substantially apply to

corresponding dependent claims 5, 19, and 29.

Referring to claims 6, 7, 18 and 30.

The Appellant did not provide additional arguments, the Appellant contents that

the arguments for independent claims 1, 14, and 26 substantially apply to

corresponding dependent claims 6, 7, 18 and 30.

Referring to claims 8, 20, and 32.

The Appellant did not provide additional arguments, the Appellant contends that

it would be moot to argue that Kennedy provides for selecting a potential contact in

either a random fashion or based on a select algorithm.

Referring to claims 9, 21, and 33.

The Appellant contends that the Kennedy reference fails to teach or suggest the

step of repeating the searching step of applicant's claims 1, 14, and 26 until the

maximum number of candidates for selection has been achieved.

The Examiner notes, Fig. 18 of Kennedy discloses a flowchart summarizing the

steps executed by a process manager when a graphically depicted communication

process is executed in real time mode. At step **458**, the process management system

determines whether or not there are any more events to be processed for the loaded

communication process. If more events exist in the loaded process, then control

passes to step **460** and the next event is selected. This process is continued until there

are no more events to be processed, i.e. a maximum number of events relating to

contact database entries has been achieved.

Referring to claims 10-11, 22-23, and 34-35.

The Appellant did not provide additional arguments, the Appellant contends that

it would be moot to argue that the Kennedy reference in combination with the Xcontact

reference would have been provided for a method for dynamically and visually

presenting potential contacts to automatically remind the user to stay in touch with the

potential contacts.

Referring to claims 12 and 13.

The Appellant did not provide additional arguments, the Appellant contents that

the arguments for independent claims 1, 14, and 26 substantially apply to

corresponding dependent claims 12 and 13.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MSG
January 11, 2005

WYNN W. COGGINS
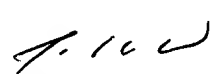SUPERVISORY PATENT EXAMINER
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